

REMARKS

Claims 1-36 have been examined. Claims 1, 3-6, 8-10 and 24-36 have been rejected under 35 U.S.C. § 112, first paragraph, claims 1, 3-6, 8-10 and 24-36 have been rejected under 35 U.S.C. § 112, second paragraph, and claims 2, 7, 11-23 have been rejected under 35 U.S.C. § 103(a).

I. Rejection of claims 1, 3-6, 8-10 and 24-36 under 35 U.S.C. § 112, first paragraph

Claims 1, 3-6, 8-10 and 24-36 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner maintains that the recitation, “wherein said host computer generates said job data of said print job when the job request is received from said printer” is not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the invention at the time the application was filed. However, as fully disclosed, for example, in the non-limiting embodiment on the bottom of pg. 6 - pg. 7, the Application discloses that in a transformed example, when a print job occurs, only job location data may be sent to the print server 25 without generating job data on the spot, and afterward, when a job request is sent from the printer 23, job data may also be generated and sent to the printer 23. Also see the non-limiting embodiment at the top of pg. 11 of the Application, which discloses that job data may not be generated until a job request is sent from the printer.

In view of the above, Applicant submits that the recitations of claims 1, 6, 24, 28 and 30 are clearly described in the specification in a manner that properly convey that the Applicant had

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possession of the claimed invention at the time of filing the Application. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 3-6, 8-10 and 24-36 under 35 U.S.C. § 112, first paragraph.

II. Rejection of claims 1, 3-6, 8-10 and 24-36 under 35 U.S.C. § 112, second paragraph

Claims 1, 3-6, 8-10 and 24-36 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Accordingly, Applicant has amended the claims in a manner believed to overcome the rejection, and respectfully requests the Examiner to withdraw the rejections.

III. Rejection under 35 U.S.C. § 103(a) over U.S. Patent No. 6,184,996 to Gase (“Gase”) in view of U.S. Patent No. 5,490,237 to Zimmerman et al. (“Zimmerman”).

Claims 11-13 and 16-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gase in view of Zimmerman.

A. Claim 11

Applicant submits that claim 11 is patentable over the cited references. For example, claim 11 recites that the job request section sends a job request to the host computer according to a condition of the print engine and the receive buffer memory.

The Examiner acknowledges that Gase fails to disclose the above feature, but contends that Zimmerman does. In particular, the Examiner maintains that Zimmerman discloses a printer

that processes a print job according to a condition of a receive buffer memory and a print engine. However, printer 12 of Zimmerman does not send a job request to the host computer 10 according to a condition of the print engine 34 and the I/O buffer RAM portions 40, 42. Rather, as disclosed in the reference, the host computer 10 determines the data transfer rate over the I/O 14 and sets the printer's buffer threshold based on the known speed of the print engine 34 (col. 5, lines 39-44). Therefore, it appears that any actions based on a condition of the print engine 34 and the I/O buffer RAM portions 40, 42, are taken by the host computer 10, rather than the printer 12. There is no disclosure that, prior to sending a job request, the printer refers to the data transfer rate, etc., such that a job request is sent according to the transfer rate and print speed of the engine 34. Thus, Applicant submits that Zimmerman fails to cure the deficient teachings of the Gase reference.

Further, in regard to the Examiner's comments, it appears that the Examiner is again maintaining that the host computer sends the print job to the printer according to a condition of the print engine and the receive buffer memory (pgs. 5 and 25 of current Office Action). However, as set forth above, claim 11 does not recite that job data is sent from the host computer to the printer according to a condition of a print engine and the receive buffer memory. Rather, as claimed, it is the job request section of the printer that sends the job request to the host computer according to a condition of the print engine and the receive buffer memory. Therefore, it appears that the Examiner is arguing a feature that is not recited in claim 11, or at least somewhat opposite to the feature recited in claim 11.

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Accordingly, Applicant submits that claim 11 is patentable over the cited references, and respectfully requests the Examiner to reconsider and withdraw the rejection.

B. Claims 12 and 13

Since claims 12 and 13 are dependent upon claim 11, Applicant submits that such claims are patentable at least by virtue of their dependency.

C. Claims 16, 17 and 18

Since claim 16 contains features which are analogous to the features recited in claim 11, Applicant submits that claim 16 is patentable for at least analogous reasons as presented above. In addition, since claims 17 and 18 are dependent upon claim 16, Applicant submits that such claims are patentable at least by virtue of their dependency.

IV. Rejection under 35 U.S.C. § 103(a) over Gase in view of U.S. Patent No. 6,385,728 to Debry (“Debry”).

Claims 2 and 7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gase in view of Debry.

A. Claim 2

Claim 2 recites that a host computer sends job location data showing a location of job data to a print server. The print server temporarily stores the job location data and sends it to the

printer. The printer then sends the job request, which the job location data shows, to the host computer.

The Examiner continues to maintain that user 20 of Debry functions as a printer server. In particular, the Examiner maintains that user 20 is a computer, and Debry teaches that computer 20 would perform both a server function, as well as other functions (pg. 39 of Office Action where Examiner cites to col. 7, lines 15-25; col. 8, lines 50-65). However, contrary to the Examiner's assertions, Applicant submits that the cited portions fail to disclose that the actual user 20 performs the server function. For example, the reference discloses a separate print server 30 that is a "computer that manages the function of a printer and device queuing either as a computer that is solely dedicated to such management, or as a computer that performs other tasks besides such management." (col. 6, line 62 - col. 7, line 1). However, as stated, such disclosure is in reference to the print server 30, not the user 20.

The reference fails to teach or such suggest that the actual user 20 performs the server function of the disclosed print server 30 (i.e. col. 6, lines 60-62). Rather, the fact that the reference discloses both the user and the printer server as separate entities, suggests that the user 20 is not intended to act as a server for the printer. Therefore, Applicant submits that user 20 of Debry fails to disclose the claimed print server, and thus, based on the disclosure provided in Debry, one skilled in the art would not be motivated to use the user 20 as the printer server.

Further, as stated above, claim 2 recites that the print server temporarily stores the job location data and sends it to the printer. The Examiner maintains that the will call certificate 40 contains the job location data, while the user 20 discloses the print server. However, as set forth

above, the user 20 does not disclose a print server since Debry already discloses printer server 30.

On the other hand, even if Applicant assumes *arguendo* that the printer server 30 of Debry discloses the claimed print server, the reference still fails to teach or suggest the features recited in claim 2. For example, as set forth in the November 10, 2003 Amendment, the user 20 takes the will-call certificate 40 and builds a print request (col. 7, lines 43-45). The user 20 sends the print request to the print server 30 (Fig. 1, col. 7, lines 43-45). Print server 30 receives the request and then goes to document source 10 to request the document (col. 7, lines 50-51). In particular, print server 30 gives the will-call certificate 40 to document source 10 to verify that the printer is allowed to get that document (col. 7, lines 51-53). After verification, document source 10 sends the requested document to the printer (col. 8, lines 32-36). Therefore, it is only the printer server 30 that receives the job location data in the will call certificate 40, and the certificate is then passed on to the document source 10. The printer server 30 itself never sends the will call certificate (i.e. job location data) to the printer, as recited in claim 2.

Accordingly, since Debry fails to cure the deficient teachings of Gase, Applicant submits that claim 2 is patentable over the cited reference.

B. Claim 7

Since claim 7 contains features which are analogous to the features recited in claim 2, Applicant submits that such claim is patentable for at least analogous reasons as presented above.

V. Rejection under 35 U.S.C. § 103(a) over Gase in view of Zimmerman.

Claims 14, 15, 19 and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gase in view of Zimmerman and Pipeline Corporation (column 1, lines 48-60 of Gase). However, since claims 14, 15, 19 and 20 are dependent upon claims 11 and 16, respectively, and Pipeline fails to cure the deficient teachings of Gase and Zimmerman, in regard to claims 11 and 16, Applicant submits that claims 14, 15, 19 and 20 are patentable at least by virtue of their dependency.

VI. Rejection under 35 U.S.C. § 103(a) over Gase in view of Debry.

Claims 21-23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gase in view of Debry.

A. Claim 21

Since claim 21 contains features which are analogous to the features recited in claim 2, Applicant submits that claim 21 is patentable over the cited references for at least analogous reasons as presented in claim 2. In particular, Applicant submits that user 20 of Debry fails to teach or disclose the claimed print server (Fig. 1).

Accordingly, since Debry fails to cure the deficient teachings of Gase, Applicant submits that claim 21 is patentable over the cited references.

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B. Claims 22 and 23

Since claims 22 and 23 contain features which are analogous to the features of claim 21, Applicant submits that such claims are patentable for at least analogous reasons as presented above.

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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